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**OFFICE OF PETITIONS**

In re Application of  
Kast, et al  
Application No. 08/170,344  
Filed: 30 March, 1994  
Attorney Docket No.: 45113/RDK/AG

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ON PETITION

This is a decision on the petition filed on 28 May, 2004, under 37 C.F.R. §1.137(b), alleging unintentional delay.

For the reasons set forth below, the petition under 37 C.F.R. §1.137(b) is **GRANTED**.

NOTES: (1) The record (including the petitions filed on 28 May and 18 August, 2004) does not necessitate a finding that the delay between midnight 14 September, 1996), and 18 August, 2004, was not unintentional.

Rather, the Patent and Trademark Office is relying in this matter on duty of candor and good faith of Petitioners and their Counsel Robert D. Katz (Reg. No. 30,141) when accepting Petitioners' representation that the delay in filing the response was unintentional.<sup>1</sup>

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<sup>1</sup> See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing the statement required by 37 C.F.R. §1.137(b) to the Patent and Trademark Office).

(2) The Terminal Disclaimer filed on 18 August, 2004, under 37 C.F.R. §1.137(d) has been entered and made of record.<sup>2</sup>

### BACKGROUND

The record reflects that:

- Petitioner failed to reply to the final Office action mailed on 14 June, 1996, with reply due absent extension of time on or before Monday, 16 September, 1996;
- the application went abandoned by operation of law after midnight 14 September, 1996;
- the Office mailed a Notice of Abandonment on 23 January, 1997;
- in the original petitions, Petitioner Robert D. Katz (Reg. No. 30,141): made a statement—but provided no documentary support for the allegation—of non-receipt of the final Office action and the Notice of Abandonment; evidenced no inquiry with copies of status inquiries or receipt cards reflecting such; failed to satisfy regulatory requirements (under 37 C.F.R. §1.137(b), as filed, for a terminal disclaimer); and (in light of the obvious difference in addresses) made no showing of timely Notice to the Office of Change of Address, and so the petitions were dismissed on 28 May and 18 June, 2004;
- Petitioner has responded to those requirements and provided the mandatory submissions under the regulation (37 C.F.R. §1.137(b)), including petition (with fee), a reply in the form of an amendment under 37 C.F.R. §1.129 (with fee), a terminal disclaimer (with fee), and statement/showing of unintentional delay37(b).

### STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).<sup>3</sup>

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<sup>2</sup> The regulations at 37 C.F.R. §1.137(d)(1) state that a terminal disclaimer filed pursuant to this rule must dedicate to the public a terminal part of the term of any patent granted thereon equivalent to the lesser of: 1) the period of abandonment of the application; or 2) the period extending beyond twenty years from the date on which the application for the patent was filed in the United States, or, if the application contains a specific reference to an earlier filed application(s) under 35 U.S.C. 120, 121 or 365(c), from the date on which the earliest such application was filed. Effective 20 September, 2000 (65 Fed. Reg. 54674, 8 September, 2000).

<sup>3</sup> 35 U.S.C. §133 provides:  
**35 U.S.C. §133 Time for prosecuting application.**

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority.

The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.<sup>4</sup> Delays in responding properly raise the question whether delays are unavoidable.<sup>5</sup> Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).<sup>6</sup>

Petitioner must be diligent in attending to the matter.<sup>7</sup> Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.<sup>8</sup>

#### Allegations as to Unintentional Delay

A grantable petition alleging unintentional delay requires: (a) a petition and fee, (b) a proper reply, (c) a statement of unintentional delay supported by further explanation and documentary evidence where required by the Commissioner, and (d) a terminal disclaimer and fee. As indicated above, Petitioner has satisfied these requirements.

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regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

<sup>4</sup> Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

<sup>5</sup> See: Changes to Patent Practice and Procedure; Final Rule Notice, 62 *Fed. Reg.* at 53158-59 (October 10, 1997), 1203 *Off. Gaz. Pat. Office* at 86-87 (October 21, 1997).

<sup>6</sup> See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

<sup>7</sup> See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 *Off. Gaz. Pat. Office* 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office supra.

<sup>8</sup> Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

CONCLUSION

The petition under 37 C.F.R. §1.137(b) is **granted**.

The instant file is forwarded to Technology Center 1800 for further processing in due course.

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-9199.

A handwritten signature in black ink, appearing to be "J. Gillon", with a large, stylized flourish extending from the end of the signature.

John J. Gillon, Jr.  
Senior Attorney  
Office of Petitions